



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,511	01/29/2004	Carl Arnold Koppel	SES-001-US	5963
<div>7590 PATRICK REILLY BOX 7218 SANTA CRUZ, CA 95061-7218</div>			<div>EXAMINER CAO, PHUONG THAO</div>	
			<div>ART UNIT 2164</div>	<div>PAPER NUMBER</div>
			<div>MAIL DATE 12/20/2007</div>	<div>DELIVERY MODE PAPER</div>

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/767,511	Applicant(s) KOPPEL ET AL.	
	Examiner Phuong-Thao Cao	Art Unit 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to Amendment/RCE filed on 10/19/2007 and entered with an RCE.
2. Claims 1-9 have been amended, and claim 10 has been cancelled. Currently, claims 1-9 are pending.

Continued Examination Under 37 CFR 1.114

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/19/2007 has been entered.

Affidavit under 37 C.F.R. § 1.131

4. The affidavit filed on 10/19/2007 under 37 CFR § 1.131 has been reviewed and considered as effective to overcome the Millet et al. reference (U.S. Application Publication No 2003/0154197, effective filing date 2/13/2002).

5. The Applicant has supplied sufficient evidence to establish reduction to practice of the claimed invention prior to 13 February 2002, the effective filing date of U.S. Publication No 2003/0154197 (the Millet et al. reference). As a result, the Millet et al. reference is no longer used as a prior art, and all references considered as prior art must be prior to 24 July 2001, which is now considered as effective date of the claimed invention.

Response to Arguments

6. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 5, 6, 8 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 5, 6, 8 and 9, language “*may be*” (line 9 and line 12 of claim 5; line 13 of claim 6; line 7 of claim 8; line 7 of claim 9) raises question whether the claim will perform the acts. It is suggested to change “may be” to “is” to overcome this rejection.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 1-9 (effective date 7/24/2001) are rejected under 35 U.S.C. 102(e) as being anticipated by Fish (US Publication No 2003/0220891, effective filing date 12/22/2000).

As to claim 1, Fish teaches:

“In a computer, a method for adding additional information into a data field of an existing software record associated with a software table” (see Fish, [0010]-[0011] and [0100]-[0102]), the method comprising:

“forming a first user-defined data field structure, or first “UDF”” (see Fish, [0015] and [0101]-[0102] for adding user-defined fields to matter record wherein each row in table (Fig.

13b) defining an identifier and a value of a user-defined field associated with a matter number is interpreted as user-defined data field structure), the first UDF comprising:

“a record identifier datafield” (see Fish, [0097], [0102] and Fig. 13a-b wherein field 1380 storing matter number is interpreted as a record identifier datafield),

“a UDF identifier datafield” (see Fish, [0102] and Fig. 13b wherein field 1381 storing identifier of a user-defined field is interpreted as a UDF identifier datafield), and

“a first datafield” (see Fish, [0102] and Fig. 13b wherein field 1382 storing value corresponding to the user-defined field is interpreted as a first datafield);

“storing a record identifier in the record identifier datafield” (see Fish, [0097] [0102] and Fig. 13b wherein matter number is interpreted as a record identifier);

“storing a UDF identifier in the UDF identifier datafield” (see Fish, [0100]-[0104] and Fig. 13b); and

“storing an additional information in the first datafield, whereby the first data field is associated with the record and the additional information stored in the first data field is associated with the record and without modification of the table” (see Fish, [0096]-[0102] and Fig. 13a-b wherein corresponding value is interpreted as additional information stored in field 1382 (first datafield) which is associated with a matter record referenced by matter number; also see [0076] and [0079]).

As to claim 2, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a metadata, the metadata comprising a classification of data type, the classification of data type distinguishing the data type of the additional information stored in the first datafile” (see Fish, [0103]); and

“associated the metadata with the first UDF” (see Fish, [0051]-[0053]).

As to claim 3, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a metadata, the metadata comprising a name, the name associated with the first UDF and the name for use in software operations accessing the first UDF” (see Fish, [0052]-[0053] wherein identifier is interpreted as a name as recited; also see [0087]); and

“associated the metadata with the first UDF” (see Fish, [0102] and [0052] wherein each user-defined field is associated with an identifier (metadata)).

As to claim 4, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a metadata, the metadata comprising a title, the title associated with the first UDF and a name for use in a visual display of additional information of the first UDF” (see Fish, Fig. 7); and

“associated the metadata with the first UDF” (see Fish, [0015] wherein field description associated with each user-defined field can be interpreted as title as claimed).

As to claim 5, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a class plurality of UDF’s and wherein the first datafield comprises a class identifier of the class plurality of UDF’s, and each UDF of the class plurality includes: the class identifier; a unique identifier of the UDF of the class plurality of UDF” (see Fish, [0017] wherein a class plurality of UDF’s includes milestones, office procedures, matter details, etc); and

“datafield, whereby each datafield of the class plurality of UDF's is associated with the first UDF and therefrom associated with the record, and information may be stored in the plurality of datafield of the class plurality of UDF, and associated with the first UDF, and therefrom the information of the plurality of datafields of the class plurality of UDF's may be associated with the record and without modification of the table” (see Fish, [0085] for associating number of addresses (the class plurality of UDF’s) with a given contact (first UDF)).

As to claim 6, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“forming a plurality of UDF’s” (see Fish, [0097], [0107] and Fig. 13a-b);

“storing an identifier of the first UDF in the record identifier datafield of each of the plurality of UDF's” (see Fish, Fig. 13b wherein matter number is interpreted as identifier of the first UDF);

“storing a unique UDF identifier in the record identifier datafield of each of the plurality of UDF’s” (see Fish, Fig. 13b);

“storing information in each of the first datafields of each of the plurality of UDF’s, whereby the plurality of first datafields of the plurality of UDF’s are associated with the first UDF and information is stored in the plurality of datafields and associated with the first UDF, and therefrom the information of the plurality of datafields may be associated with the record and without modification of the table” (see Fish, Fig. 13 a-b for associating of values (information in the plurality of datafields) with a matter number (first UDF) which represent a matter record [0097]; also see [0085] and [0101] for associating number of addresses with a given contact wherein each identifier/value pair represents an user-defined field).

As to claim 7, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“storing a pointer in the record identifier datafield for use as the record identifier” (see Fish, [0101] for storing a pointer to an identifier).

As to claim 8, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

“each UDF associated with a same record stored in the table, whereby the plurality of first datafields of the plurality of UDF’s are associated with the same record and information is

stored in the plurality of datafields and the information of the plurality of datafields may be associated with the same record and without modification of the table" (see Fish, [0097], [0102]-[0103] and Fig. 13 a-b for the association between many user-defined fields (identifier/value pairs) with a matter number (matter record)).

As to claim 9, this claim is rejected based on arguments given above for rejected claim 1 and is similarly rejected including the following:

Fish teaches:

"forming a data structure having a record, a List and a list user-defined field or "List UDF", the List UDF relatable to the record, and the List UDF comprising: an identifier of the List UDF; an identifier of the List, and a data address of the list, whereby an information stored at the data address of the List is associated with the List UDF and the information may be stored or modified at the data address of the List, and the information is associated with the record and without modification of the table" (see Fish, [0085], [0087] for a list of addresses associated with a contact record; see [0052] for a list of milestone identifiers associated with a matter record; also see [0101] for storing pointer to an identifier (e.g., list) wherein pointer is interpreted as data address of the list).


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phuong-Thao Cao whose telephone number is (571) 272-2735. The examiner can normally be reached on 8:30 AM - 5:00 PM (Mon - Fri).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Phuong-Thao Cao
Art Unit 2164
December 12, 2007


CHARLES RONES
SUPERVISORY PATENT EXAMINER